

AMENDMENTS TO THE DRAWINGS:

Figure 6 is amended to correct an error in the text of the box labeled 132 at the bottom of the figure. The box incorrectly said “REJECT BOOK”. The amendment corrects the text within the box to say “STACK/BUNDLE BOOKS”. The corrected language reflects the process as described in the originally-filed specification, in the paragraph beginning at line 9 of page 7. As such, no new matter is added. A replacement drawing sheet in accordance with 37 CFR 1.121(d) is attached.

REMARKS:

Claims 1-31 were originally pending in the present application. By the present amendment, Applicants amend claims 1, 9-11, 15, 21, 23, 24, and 28-31. Applicants cancel claim 27 such that claims 1-26 and 28-31 are pending in the present application.

Claim Rejections under 35 U.S.C. §112, first paragraph

Claims 8, 14, and 20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for the reason that neither the specification, nor the drawings contain any indication on how the alternate piece will be generated and sent to the recipient in electronic format.

Applicants submit that the subject matter of the rejected claims, specifically the alternate piece being in electronic format, is duly described in the specification at multiple locations. For example, reference is made to electronic format replacement pieces in the specification at page 3, lines 21-22; page 3, lines 29-31; page 5, lines 12-15; page 5, lines 17-20; and page 6, lines 7-9.

According to the MPEP Section 2163, an adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. Additionally, the burden of proving the written description to be deficient is upon the Examiner. The Examiner must set forth express findings of fact regarding the analysis which supports the lack of written description conclusion. These findings should establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation is not a sufficient reason to support a rejection for lack of adequate written description.

Generating and sending articles of electronic format is well known in the art, and is clear to one of ordinary skill in the art. For example, one of ordinary skill in the art, at the time the invention was made, would not question the methods necessary to record and mail a compact disc, write and send an e-mail through the internet, record data on magnetic tape and mail the same, etc. Such practices are well-known in the prior art, are easily understood (even by those

without skill in the art), and are not required to be described in fine detail in order to communicate Applicants' invention.

Accordingly, Applicants respectfully request that the rejections be withdrawn and claims 8, 14, and 20 be allowed.

Claim Rejections under 35 U.S.C. §112, second paragraph

Claim 21 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner points to line 5 "loading the pre-personalized printed products adjacent the binding line" as contradicting the specification and the drawings.

In the specification at page 3, lines 20-31, the binding line of Fig. 1 is introduced. The binding line is for assembling books. The binding line includes feeders and a conveyor line. One or more feeders feed pre-personalized pieces to the binding line.

On page 7, lines 7-8 of the specification, the application states that pre-personalized printed products are generated off-line (Fig. 6, step 122) and loaded adjacent a binding line in the order the recipients appear on the mailing list (Fig. 6, step 124). Books are then bound and assembled on the binding line, some of which include pre-personalized printed products. Applicants point out that the binding line of Fig. 1 can be used in performing the method recited in claim 21.

Accordingly, Applicants respectfully request that the rejection be withdrawn and claim 21 allowed.

Claim Rejections under 35 U.S.C. §102(b) – U.S. 3,819,173

The Examiner rejects claims 1-3, 5-7, 9-12, 15-17, 19, 24, 25, and 27-29 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 3,819,173 ("Anderson").

Independent Claim 1

Claim 1 defines a binding method including the steps of generating a pre-personalized book on a binding line for a specific individual, rejecting selective pre-personalized books, and generating an alternate piece, having an alternate format from the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.

Anderson discloses a method for producing magazines including punching/printing and inserting subscription renewal cards for selected individual subscribers as the subscriber's magazine is being made up. In the event of a fault, the magazine is rejected and reordered. A new card is punched and/or printed for insertion in the magazine. The new magazine must then be coordinated with the other magazines for downstream sorting and mailing operation.

The new magazine and new renewal card are created and assembled to replace the rejected magazine. Thus, the replacement magazine is identical to the original, rejected magazine (with the exception that it may be without the faults of the rejected magazine), complete with an identical renewal card. There is no teaching or suggestion by Anderson to replace a rejected magazine with an item of alternate format for delivery to the subscriber. Anderson's sole intent and teaching is to create the one, predetermined format (magazine including renewal card) whether it be an original or a replacement.

Therefore, Anderson fails to teach or suggest generating an alternate piece, having an alternate format from the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.

Claim 1 is allowable for this and other reasons. Claims 2-8 depend from claim 1 and are allowable for the same and other reasons.

Independent Claim 9

Claim 9 defines a binding method including generating a mailing list of recipients, generating a pre-personalized book for each recipient on a binding line, rejecting one of the pre-personalized books, identifying the recipient of the rejected pre-personalized book, and generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding their pre-personalized book.

As discussed above, Anderson discloses a method for producing magazines including subscription renewal cards for selected individual subscribers. In the event of a fault, the magazine is reordered, and a new card is punched and/or printed for insertion in the magazine. The new magazine and new renewal card are identical to the original. There is no teaching or suggestion by Anderson to replace a rejected magazine with an alternate piece. Anderson's only teaching is to create the magazine and renewal card as originally prescribed, whether it is an original or a replacement. There is also no teaching or suggestion by Anderson to include a

notification to the subscriber regarding their magazine on an alternate piece that replaces the magazine. In fact, it would not be perceivable for Anderson to do so because the subscriber is receiving the magazine, not an alternate piece.

Therefore, Anderson fails to teach or suggest generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding their pre-personalized book.

Claim 9 is allowable for this and other reasons. Claims 10-14 depend from claim 9 and are allowable for the same and other reasons.

Independent Claim 15

Claim 15 defines a method of replacing a rejected book on a binding line. The method includes generating a mailing list of recipients having a mailing order, assembling a pre-personalized book on the binding line for each recipient according to the mailing list, rejecting selective pre-personalized books, generating an alternate piece on the binding line, and replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order.

Anderson discloses making renewal cards on the binding line. Anderson further discloses making replacement renewal cards on the binding line (i.e., replacing cards that are rejected with rejected magazines). However, a replacement renewal card is not an “alternate piece”—it is the same piece. It is an exact replica of the original that was discarded. Furthermore, a renewal card does not replace a rejected magazine, taking its place in the mailing order on the binding line. The replacement renewal card, which is inserted into the replacement magazine, replaces only the original renewal card.

Therefore, Anderson fails to teach or suggest generating an alternate piece on the binding line and replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order.

Claim 15 is allowable for this and other reasons. Claims 16-20 depend from claim 15 and are allowable for the same and other reasons.

Independent Claim 24

Claim 24 defines a binding method including generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature, rejecting selective pre-personalized books, reprinting the pre-personalized signature of one of the rejected pre-personalized books, and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

Anderson discloses printing and/or punching a new renewal card for insertion into the replacement magazine. Column 1, paragraph 3 of Anderson suggests that a particular magazine title may include different advertising (e.g., different signatures) for different subscriber groups. However, Anderson fails to teach or suggest a binding method in which a pre-personalized signature is reprinted for a specific individual's magazine after the original magazine with the specific individual's original pre-personalized signature is rejected. Magazines, whether new or reordered, are assembled from signatures already in the inserter (10), rather than being specifically reprinted for a particular subscriber's magazine.

Therefore, Anderson fails to teach or suggest reprinting the pre-personalized signature of one of the rejected pre-personalized books and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

Claim 24 is allowable for this and other reasons. Claims 25 and 26 depend from claim 24 and are allowable for the same and other reasons.

Independent Claim 28

Claim 28 defines a binding method including generating a mailing list of recipients, generating a pre-personalized printed product for each recipient, assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece, rejecting selective books, removing the rejected books from respective spaces along the binding line, generating an alternate pre-personalized piece for each recipient whose book was rejected, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

Anderson discloses only reproducing a magazine and renewal card that were previously rejected, rather than generating an alternate pre-personalized piece for the subscriber's whose magazines were rejected. Anderson discloses reordering the rejected magazine as soon as possible, but makes no teaching or suggestion that the reordered magazine is inserted into the space on the binding line that was previously occupied by the rejected magazine. Anderson suggests that the reordered magazine should be produced during the same zip code run for proper grouping, but when a magazine is rejected near the end of a zip code run, manual intervention is necessary to get the reordered magazine back to the correct zip code group (column 10, lines 27-36). If the reordered magazine were placed in the vacant space of the rejected magazine, there would be no concern for upsetting the zip code groups and manual assembly would not be needed.

Therefore, Anderson fails to teach or suggest removing rejected books from respective spaces along the binding line, generating an alternate pre-personalized piece for each recipient whose book was rejected, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

Claim 28 is allowable for this and other reasons. Claims 29 and 30 depend from claim 28 and are allowable for the same and other reasons.

Claim Rejections under 35 U.S.C. §102(b) – U.S. 6,347,260

The Examiner rejects claims 21 and 23 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,347,260 ("Graushar").

Independent Claim 21

Claim 21 defines a binding method including generating a mailing list of recipients, generating a pre-personalized printed product off-line for selected recipients on the mailing list, loading the pre-personalized printed products adjacent a binding line, assembling a book for each recipient including a respective pre-personalized printed product, rejecting selective recipients' books, removing the rejected books from the binding line, and generating an alternate piece in place of each rejected book, the alternate piece being of a different format than the pre-personalized printed product.

Graushar discloses a multi-mailer, which combines pre-personalized printed items and items that are not pre-personalized in zip code order. Unacceptable books are rejected and

replaced by generic books (column 2, line 66 to column 3, line 4). Personalization on inside pages of select books occurs after the inspection.

Graushar does not teach or suggest generating an alternate piece in place of each rejected book, the alternate piece being of a different format than the pre-personalized printed product. Graushar discloses rejecting a book and replacing it with another book. The replacement book contains signatures and optionally, insert cards like the rejected book, but it is not personalized or enhanced. The information contained in the generic book may not be exactly the same as the rejected book, but the format (i.e., the signatures and inserts that make up the replacement) is the same as that contained within the rejected book.

Therefore, Graushar does not teach or suggest assembling a book for each recipient including a respective pre-personalized printed product and generating an alternate piece in place of each rejected book, the alternate piece being of a different format than the pre-personalized printed product.

Claim 21 is allowable for this and other reasons. Claims 22 and 23 depend from claim 21 and are allowable for the same and other reasons.

Claim Rejections under 35 U.S.C. §103(a) – Anderson in view of U.S. 5,428,423

The Examiner rejects claims 4, 13, 18, 26 and 30 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of United States Patent No. 5,428,423 ("Clark").

Dependent Claim 4

Claim 4 depends from claim 1, which is discussed in detail above. Applicants submit that claim 1 is allowable over Anderson for at least the reasons discussed above. Clark does not cure the deficiencies of Anderson with respect to claim 1. Therefore, claim 4 is allowable at least for the same reasons as claim 1. Furthermore, claim 4 defines additional subject matter. Accordingly, Applicants request withdrawal of the rejection and allowance of claim 4.

Dependent Claim 13

Claim 13 depends from claim 9, which is discussed in detail above. Applicants submit that claim 9 is allowable over Anderson for at least the reasons discussed above. Clark does not cure the deficiencies of Anderson with respect to claim 9. Therefore, claim 13 is allowable

at least for the same reasons as claim 9. Furthermore, claim 13 defines additional subject matter. Accordingly, Applicants request withdrawal of the rejection and allowance of claim 13.

Dependent Claim 18

Claim 18 depends from claim 15, which is discussed in detail above. Applicants submit that claim 15 is allowable over Anderson for at least the reasons discussed above. Clark does not cure the deficiencies of Anderson with respect to claim 15. Therefore, claim 18 is allowable at least for the same reasons as claim 15. Furthermore, claim 18 defines additional subject matter. Accordingly, Applicants request withdrawal of the rejection and allowance of claim 18.

Dependent Claim 26

Claim 26 depends from claim 24, which is discussed in detail above. Applicants submit that claim 24 is allowable over Anderson for at least the reasons discussed above. Clark does not cure the deficiencies of Anderson with respect to claim 24. Therefore, claim 26 is allowable at least for the same reasons as claim 24. Furthermore, claim 26 defines additional subject matter. Accordingly, Applicants request withdrawal of the rejection and allowance of claim 26.

Dependent Claim 30

Claim 30 depends from claim 28, which is discussed in detail above. Applicants submit that claim 28 is allowable over Anderson for at least the reasons discussed above. Clark does not cure the deficiencies of Anderson with respect to claim 28. Therefore, claim 30 is allowable at least for the same reasons as claim 28. Furthermore, claim 30 defines additional subject matter. Accordingly, Applicants request withdrawal of the rejection and allowance of claim 30.

Claim Rejections under 35 U.S.C. §103(a) – Graushar in view of Clark

The Examiner rejects claim 22 under 35 U.S.C. §103(a) as being unpatentable over Graushar in view of Clark.

Dependent Claim 22

Claim 22 depends from claim 21, which is discussed in detail above. Applicants submit that claim 21 is allowable over Graushar for at least the reasons discussed above. Clark does not cure the deficiencies of Graushar with respect to claim 21. Therefore, claim 22 is allowable

at least for the same reasons as claim 21. Furthermore, claim 22 defines additional subject matter. Accordingly, Applicants request withdrawal of the rejection and allowance of claim 22.

Claim Rejections under 35 U.S.C. §103(a) – Anderson in view of Graushar

The Examiner rejects claim 31 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Graushar.

Independent Claim 31

Claim 31 defines a method of replacing a rejected book on a binding line, including generating a mailing list of recipients, assembling a pre-personalized book on the binding line for each recipient, rejecting selected pre-personalized books, replacing a first rejected book with a generic book, replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and replacing a third rejected book with an alternate format piece.

The disclosures of both Anderson and Graushar are discussed above. Anderson discloses a replacement that is identical to what the rejected book should have been, including a renewal card that is punched/printed on-line. Graushar discloses replacement of a rejected book with a generic book. Neither Anderson, nor Graushar, nor a combination thereof teaches or suggests replacing a rejected book with an alternate format piece. Each of Anderson and Graushar replace a rejected item with another item of the same format. Furthermore, neither Anderson, nor Graushar, nor a combination thereof teaches or suggests a method of replacing books on a binding line that includes three separate replacement variations which are: generic book, regenerated book identical to what the book should have been, and alternate format piece.

Therefore, Anderson and Graushar, either alone or in combination fail to teach or suggest replacing a first rejected book with a generic book, replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and replacing a third rejected book with an alternate format piece.

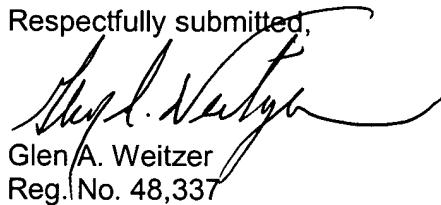
Accordingly, claim 31 is allowable for at least these reasons. Applicants respectfully request withdrawal of the rejection and allowance of claim 31.

Conclusion

Applicants amend the present application such that claims 1-26 and 28-30 are pending. By the present Amendment and arguments contained herein, Applicants believe all the currently pending claims to be in condition for allowance. Therefore, Applicants respectfully request reconsideration of the rejections and allowance of claims 1-26 and 28-31.

The Examiner is invited to contact the undersigned attorney should the Examiner determine that such action would facilitate the prosecution and allowance of the present application.

Respectfully submitted,



Glen A. Weitzer
Reg. No. 48,337

Docket No.: 077047-9497-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108

(414) 271-6560